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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,296	06/20/2001	Atsushi Shimizu	15115/003001	2665

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/885,296

**Applicant(s)**

SHIMIZU, ATSUSHI

**Examiner**

Jonathan Ouellette

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The Request filed on 3/18/2004 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/885,296 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Response to Amendment***

2. Claims 1-36 have been cancelled and Claims 37-42 have been added; therefore, Claims 37-42 are currently pending in application 09/885,296.

### ***Claim Rejections - 35 USC § 101***

3. The rejection of Claims 23-28, 35, and 36 under 35 U.S.C. 101 is withdrawn due to applicant's amendments/cancellations.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 37-42 are rejected under 35 U.S.C. 103(a) as being anticipated by **Bechet et al. (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).**
6. As per independent Claim 37, Bechet discloses a method executed in a computer to form a development plan (retraining) for an individual in an organization, the method comprising: (a) receiving an answer pattern for questions through an interface of the computer (automation of known staffing analysis process, pg. 9), obtaining capability information comprising a capability type in the organization and a capability amount by comparing the answer pattern with a determining table (skills matrix) stored in a memory of the computer (required competencies/skills, pg.9) (Skills Matrix, "Head Contents" – Automated System, pg.3, pg.5); (b) comparing the capability amount with a first predetermined criterion for the respective capability types (defining staffing gaps, pgs. 10-11), retrieving, as a strong capability type of the individual, the capability type that exceeds the first predetermined criterion; (c) accumulating the capability amounts of the respective individuals in the organization for the respective capability types, comparing the accumulated capability amount with a second predetermined criterion for the respective capability types, retrieving, as a *weak* capability type in the organization, the capability type of the accumulated capability amount that falls below the second predetermined criterion (defining staffing gaps, pgs.10-11); (d) specifying a record regarding a specific individual having the strong capability that matches with the weak capability type in the organization under a database of the computer (individual with high potential/talent, pgs.11-12), wherein the

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database comprises a plurality of records of individuals, (e) forming the development plan (Action Plan, pg.3) of the specific individual, such that the development plan shows the strong capability type as a recommended capability type the specific individual needs to enhance (pg.12, *High potentials are identified for participation in development actions*; pg.11, Given an assessment of alternative actions to address anticipated staffing needs, it is necessary to evaluate the current capabilities and *development needs of talent*, define action plans...); (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

7. Bechet fails to expressly disclose outputting the formed development plan in a predetermined output form with an output device of the computer.
8. However, Bechet does disclose using computer-based models (pg.11) to perform business-planning operations to include the calculation of staffing gaps (e.g., shortages or surpluses in required skills or staffing levels, pg. 10), and the output of such a calculation would have been obvious to include with and computer-based operation at the time the invention was made. Furthermore, it would have been obvious to include the additional business identification/planning/action steps disclosed by Bechet in a computer-based model, as it would simply be a matter of automating a well-known business process.
9. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included outputting the formed development plan in a predetermined output form with an output device of the computer in the system disclosed by Bechet, for the advantage of providing a method of forming a

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development plan for an individual in an organization, with the ability to more effectively and efficiently process/report the business data by using computer automation (pg.11).

10. As per Claims 38, Bechet discloses obtaining a present capability information and a future capability information, retrieving a future strong capability type for the respective individuals and a future weak capability type in the organization, and retrieving the specific individuals having the future strong capability type that matches with the future *weak* capability type in the organization (staffing gap analysis for future demands, pg. 8-11).
11. As per independent Claim 39, Bechet discloses a method executed in a computer to select an individual to be supplemented for an organization (Recruitment, Redeployment), the method comprising: (a) receiving an answer pattern for questions through an interface of the computer (automation of known staffing analysis process, pg. 9), obtaining capability information comprising a capability type in the organization and a capability amount by comparing the answer pattern with a determining table (skills matrix) stored in a memory of the computer (required competencies/skills, pg.9) (Skills Matrix, "Head Contents" – Automated System, pg.3, pg.5), storing individual information associated with the capability information into a database of the computer; (required competencies/skills, pg.9) (Skills Matrix, "Head Contents" – Automated System, pg.3, pg.5) (b) comparing the capability amount with a first predetermined criterion for the respective capability types (defining staffing gaps, pgs. 10-11), retrieving, as a strong capability type of the individual, the capability type that exceeds the first

predetermined criterion; (c) accumulating the capability amounts of the respective individuals in the organization for the respective capability types, comparing the accumulated capability amount with a second predetermined criterion for respective capability types, retrieving, as a weak capability type in the organization, the capability type of the accumulated capability amount that falls below the second predetermined criterion (defining staffing gaps, pgs.10-11); (d) retrieving a specific individual information having the strong capability type that matches with the weak capability type in the organization from the database (Evaluate Current Talent, pg.11; Action Plans – closing gaps with recruiting and movement, pg.12) (Bechet, Thomas P; Walker, James W, “Aligning Staffing with Business Strategy,” Human Resource Planning, v16n2, pp:1-16, 1993).

12. Bechet fails to expressly disclose outputting a result of the step in a predetermined output form with an output device of the computer.
13. However, as explained above, Bechet does disclose using computer-based models (pg.11) to perform business-planning operations to include the calculation of staffing gaps (e.g., shortages or surpluses in required skills or staffing levels, pg. 10), and the output of such a calculation would have been obvious to include with and computer-based operation at the time the invention was made. Furthermore, it would have been obvious to include the additional business identification/planning/action steps disclosed by Bechet in a computer-based model, as it would simply be a matter of automating a well-known business process.

14. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included outputting a result of the step in a predetermined output form with an output device of the computer in the system disclosed by Bechet, for the advantage of providing a method for selecting an individual to be supplemented for an organization, with the ability to more effectively and efficiently process/report the business data by using computer automation (pg.11).
15. As per Claims 40, Bechet discloses obtaining a present capability information and a future capability information, retrieving a future strong capability type for the respective individuals and a future *weak* capability type in the organization, and retrieving the specific individuals having them future strong capability type that matches with the future *weak* capability type in the organization (staffing gap analysis for future demands, pg. 8-11).
16. As per Claims 41, Bechet discloses wherein the method holds the accumulated capability amount as a previous accumulated capability amount, re-executed the steps (b) and (c) after executing the step (e), and retrieves the progress of the capability in the organization base on the re-accumulated capability amount and the previous accumulated capability amount (pgs.5-6 – staffing analysis and planning is not merely a “one time” project”).
17. As per independent Claim 42, Bechet discloses a method executed in a computer to select an individual to be moved from a first organization to a second organization (moved, redeployment), the method comprising: (a) receiving an answer pattern for questions through an interface of the computer (automation of



known staffing analysis process, pg. 9), obtaining capability information comprising a capability type in the organization and a capability amount by comparing the answer pattern with a determining table (skills matrix) stored in a memory of the computer; (required competencies/skills, pg.9) (Skills Matrix, "Head Contents" – Automated System, pg.3, pg.5) (b) comparing the capability amount with a first predetermined criterion for the respective capability types (defining staffing gaps, pgs. 10-11), retrieving, as a strong capability type of the individual, the capability type that exceeds the first predetermined criterion; (c) accumulating the capability amounts of the respective individuals in the organization for the respective capability types, comparing the accumulated capability amount with a second predetermined criterion for respective capability types, retrieving, as a weak capability type in the organization, the capability type of the accumulated capability amount that falls below the second predetermined criterion for the respective organizations, retrieving, as a surplus capability in the organization, the capability type of the accumulated capability amount that exceeds the second predetermined criterion for the respective organizations (defining staffing gaps, pgs.10-11); (d) if the retrieved surplus capability type in the first organization matches with the retrieved weak capability type in the second organization, specifying a specific individual having the strong capability type that matches with the surplus capability type in the first organization (Evaluate Current Talent, pg.11; Action Plans – closing gaps with recruiting and movement, pg.12) (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

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18. Bechet fails to expressly disclose outputting a result of the step as a candidate for moving to the second organization in a predetermined output for with an output device of the computer.
19. However, as explained above, Bechet does disclose using computer-based models (pg.11) to perform business-planning operations to include the calculation of staffing gaps (e.g., shortages or surpluses in required skills or staffing levels, pg. 10), and the output of such a calculation would have been obvious to include with and computer-based operation at the time the invention was made. Furthermore, it would have been obvious to include the additional business identification/planning/action steps disclosed by Bechet in a computer-based model, as it would simply be a matter of automating a well-known business process.
20. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included outputting a result of the step as a candidate for moving to the second organization in a predetermined output for with an output device of the computer in the system disclosed by Bechet, for the advantage of providing a method for selecting an individual to be moved from a first organization to a second organization, with the ability to more effectively and efficiently process/report the business data by using computer automation (pg.11).

#### ***Response to Arguments***

21. Applicant's arguments filed 8/20/2003, with respect to Claims 37-42, have been considered but are not persuasive.

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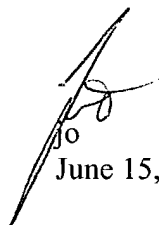
22. The applicant has made the argument that the prior art of Bechet fails to disclose calculating a strong capability type of an individual and a weak capability type in an organization, let alone how to calculate them.
23. However, Bechet does disclose a process for determining staffing gaps (gaps between desired and actual capabilities; deficits in employees with required competencies, pg.5), which begins by determining business demands/requirements (pg.9), defining current/future staffing (levels and competencies) availability (pg.10), identifying staffing gaps (shortages or surpluses in required skills [organizationally/individually] – organizational requirements minus available individual talent) (pg.10-11), and finally the action plan that would balance the staffing gap (recruitment, movement, or development) (pg. 10-11).

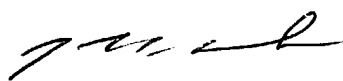
### ***Conclusion***

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

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26. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

  
June 15, 2004

  
JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600